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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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5514	7590	09/07/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			VY, HUNG T	
			ART UNIT	PAPER NUMBER
			2163	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/708,585

Applicant(s)

BEENAU ET AL.

Examiner

Hung T. Vy

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ( <u>see office action</u> ). | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

**Summary of claims**

1. Claims 1-22 are pending.  
Claims 1-22 are rejected.

**Information Disclosure Statement**

2. The information disclosure statement (IDS) submitted on 4/28/2005, 8/20/2004, 3/17/2004, and 3/12/2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

The information disclosure statement filed on 5/02/2005, 3/19/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

**Claim Rejections - 35 USC 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-22 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is "useful, tangible and concrete.

(See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

According to the New Guidelines of October 26, 2005, which states that “A claim limited to a machine or manufacture, which has a practical application, is statutory. In most cases a claim to a specific machine or manufacture will have a practical application. See Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557)... a specific machine to produce a useful, concrete, and tangible result and State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

(Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility <[http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101\\_20051026.pdf](http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101_20051026.pdf)> )

Examiner requests Applicant to include in Applicant's claimed limitations (in all the claims) the following:

What is the practical application?

What is the result?

What is final result that is concrete, useful and tangible?

Because the “practical application, result, concrete, useful and tangible” limitations are not claimed in Applicant's claims 1, 15 and 22, Examiner believes that the above listed claims are nonstatutory, the claims recite adding the first and second data set and storing them in RF transaction device without recite any thing about the result, useful and tangible.

In the represent case, claim 1, recite a transaction instrument program, however the components of a transaction instrument are merely software per se. A transaction instrument program must recite physical structure thus enabling it to be properly categorized in one of the statutory categories of invention. Since the components of an instrument claims in claim 1 is software per se and do not contain any physical components, the transaction instrument can not be categorized in one of the statutory categories of invention and is thus nonstatutory.

### Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/708550 and claims 12-35 of copending Application No. 10/709,815. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations in this application and those copending Applications are the same.

The following are the matching claims.

10708550	10/708585	10/709,815
1, 10 and 14	1, 15 and 22	12, 26, and 33

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the financial transaction instrument" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 4, the phrase "issuance of the financial transaction instrument by an issuer" renders claim indefinite because it is not clear who is the issuer, are they the first owner or second owner, how is the issuance of the RF transaction device.

Claim 8 recites the limitation "the financial transaction instrument" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the financial transaction instrument" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the financial transaction instrument" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 22, line 18, phrase "financial transaction instrument" renders claim render claim indefinite and confuse because it is not clear "financial transaction instrument" is "a transaction instrument" that recites in line 2 or line 6 of claim 21.

Claims 23-24 depend to claim 22 so claims 23-24 are rendered claims indefinite.

**Claim Rejections - 35 USC § 102**

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 5-7, 10, 13, and 15-21 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Frieden et al. (U.S. patent No. 6,480,100).

Regarding to the claim 1, Frieden et al. discloses a method for facilitating the management of a plurality of data sets on a transaction instrument, the method comprising the steps of: facilitating enrollment of a first data set owner and a second data set owner in multiple transaction accounts (multiple users of a tag)(see column 3, line 30+) on a transaction instrument program (see column 3, line 35-41 and column 7, line 15-20), facilitating adding to a database (RFID tag data storage member), a first data set of a first format at the transaction instrument (RFIT tag), wherein said first data set is owned by said first data set owner (tag user); facilitating adding to a database (RFID tag data storage member), a second data set of a second format at the transaction instrument (RFIT tag), wherein said second data set is owned by said second data set owner (tag user), wherein said first owner (tag user) is distinct from said second owner (see column 3, line 61-68), and said first format is different from said second format (see column 3, line 61-68), wherein said first data set is stored in accordance with said first format, and said second data set is stored in accordance with said second format(see column 7, line 15-39 or see

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column 16, line 1-40), and facilitating modifying at least one of said first and second data set on said database (see column 4, line 60+ or column 8, line 16+).

Regarding to the claim 2, Friedent et al. discloses database is a remote database remote from said transaction instrument (see column 4, line 4+).

With respect to claim 3, Friedent et al. discloses database is a RF transaction instrument database (RFID tag data storage member).

With respect to claims 5-6, Frieden et al. discloses facilitating the modification of a first condition header (header format) to one of said first and second data sets, said header added independent of said first or second format (see column 7, line 67)(the data format and header format) and facilitating the modification of at least one of said first and second data sets onto said transaction device database (RFID tag) in accordance with said condition header (see column 7, line 20-40).

With respect to claim 7, Frieden et al. discloses the deleting of said second data set in accordance with said condition header (Frieden et al. discloses that depending on what kind of the format of header, the tag interrogator may search internally for that particular format, formatting (deleting) and write the news data format (see column 7, line 40+).

With respect to claims 10 and 13, Frieden et al. discloses first and second data sets are each stored as a block of binary (see column 5, line 55-60 and column 7, line 22).

With respect to claim 15, Frieden et al. discloses a system for facilitating the management of a plurality of data sets stored on a RF operable transaction instrument, said transaction instrument comprising: at least one data storage area (the RFID tag transponder) configured to store a first data set in a first format and a second data storage area (the RFID tag transponder)



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configured to store a second data set in a second format different from said first format (see column 3, line 25-35), said first data set associated with a first owner (tag user) and said data storage area configured to store said first data set in said first format independent of said second data set (see column 3, line 29+), and, said second data set associated with said second owner (tag user) and said data storage area configured to store said second data set in said second format independent of said first data set(see column 3, line 29+); a remote database (the RFID tag)(see column 16, line 24) configured to store a exact duplicate representation of said first data storage area and said second data storage area (the RFID tag transponder); and an interaction device (RFID tag interrogator) configured to read and write data to said transaction device storage area (the RFID tag data storage), said interaction device (RFID tag interrogator) configured to receive said first and second data base, and to provide said first and second data sets to said transaction instrument data base (see column 16, line 10-40).

With respect to claims 16-18, Frieden et al. discloses facilitating the modification of a first and second data sets stored o said remote database is annotated with a condition header (header format) (see column 7, line 67)(the data format and header format) and facilitating the modification of at least one of said first and second data sets onto said transaction device database (RFID tag) in accordance with said condition header (see column 7, line 20-40).

With respect to claims 19, Frieden et al. discloses said condition header is at least one of the following status conditions: loaded (see column 7, line 1+).

With respect to claims 20, Frieden et al. discloses a first data storage area, wherein said first data storage area is configured to receive data of any format (see column 3, line 25-30).

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With respect to claim 21, Frieden et al. discloses RF transaction device includes a transponder operable to communicate in a contact less environment (see column 5, line 12-15).

8. Claims 22-24 are rejected under 35 U. S. C. § 102 (b) as being anticipated by Taylor (U.S. patent No. 5,578,808).

With respect to claims 22-24, Taylor discloses a multiple-application data card (see abstract) and transaction/data management system (column 2, line 24+). As show in fig. 1, the card contains a plurality of data sets. Data sets associated with Visa or Mastercard is considered an open transaction instrument since Visa or MasterCard is received virtual everywhere. In case where the card is used with an oil company or hotels, the card is used in a closed system (see column 3, line 20+). Information on any one of the cards can be updated (col. 4, line 9-16). If a card is used in ATM embodiments, the ATM or the terminal is a self-service user interaction device.

### **Claim Rejections - 35 U.S.C. § 103**

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4, 8-9, 11-12, 14 and 22-24 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Frieden et al. (U.S. patent No. 6,480,100) in view of Wischerop et al. (U.S. Patent No. 5,955,951).

Regarding claims 4, 8-9 and 11-12 and 14, with best understood, Frieden et al. discloses first data set is added before issuance of the transaction instrument by an issuer, and wherein said

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second data set is added after issuance of the transaction instrument (Frieden et al. discloses the interrogator is provided/loaded with the data format to correctly data on a corresponding portion of the tag so the first data set is already in the RFID tag store database and the interrogator reads, corrects and writes the second data set (see column 7, line 60+), each user using an assigned portion and location of the available tag memory and formatting the data contained within their respective portion in a data format different from the other tag users (column 3, line 60-67)), but Frieden does not discloses the financial transaction. Wischerop et al. discloses the RFID is financial transaction device (see column 8, line 50+). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Frieden et al.'s system by having the RIFD as financial transaction device in order to provide a different kind of using the RIFD for state purpose has been well known in the art as evidenced by the teaching of Wishcherop et al. (see column 7, line 60+).

With respect to claims 22-24, Frieden et al. discloses a data management system comprising: a transaction instrument (the RFID tag transponder) associated with a first data set of first format and a second data set of a second data format (see column 3, line 25-35), wherein said first data set is owned by a first owner (tag user) and said second data set is owned by a second owner different from the first (see column 3, line 29-35 and column 16, line 10-40), and wherein said transaction instrument (the RFID tag transponder) is configured to facilitate at least one of a first data set owner and a user of said transaction instrument in managing said first data set without involvement of an issuer of said transaction instrument)(an RFID tag user may select and define a series of data elements/files the user desires to store on the tag and the tag user may store the data format in the a data format file and provide that data format without the

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involvement of issuer of RFID tag transponder) (see column 3, line 1-35) and independent of any other data set owner (see column 3, line 30-35)), a database (the RFID tag storage) configured to store said first and second data sets, said first data set having a format different from said second format, said database configured to store said first data set in accordance with said first format, and said database configured to store said second data sets in accordance with said second format, and an interaction device (the interrogator) configured to communicate with transaction instrument and said database (the RFID tag storage), said interaction device (the interrogator) configured to receive said first and second data set and to provide said first and second data to said transaction instrument (see column 16, line 10-40) but Frieden does not disclose the financial transaction. Wischerop et al. discloses the RFID is financial transaction device (see column 8, line 50+). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Frieden et al.'s system by having the RFID as financial transaction device in order to provide a different kind of using the RFID for state purpose has been well known in the art as evidenced by the teaching of Wischerop et al. (see column 7, line 60+).

### Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung T. Vy whose telephone number is (571) 2721954. The examiner can normally be reached on 8-5.

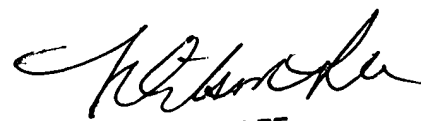
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don K. Wong can be reached on (571)2721934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hung T. Vy  
Art Unit 2163

September 1, 2006.



WILSON LEE  
PRIMARY EXAMINER

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